

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Serial No. : 10/524,996

Applicants : Hiroyuki ASADA et al.

Filed : February 18, 2005

For : STABLE OPHTHALMIC SOLUTION
COMPRISING LATANOPROST AS
ACTIVE INGREDIENT

Art Unit : 1612

Examiner : Walter E. WEBB

Docket No. : 05105/HG

Confirm No. : 3212

Customer No.: 01933

**RECORD OF SUBSTANCE OF
INTERVIEW BY APPLICANTS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP RCE

S I R :

In response to the requirement that applicants provide a statement of the substance of the March 17, 2008 telephone interview, applicants provide the following statement:

The undersigned had a telephone interview with Examiner Webb and Supervisory Examiner Krass on March 17, 2008 regarding the following statement at the top of the last page of the February 21, 2008 ADVISORY ACTION:

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Dorothy DeFrancesco
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In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by Form PTO-2038 attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper to Account No. 06-1378.

"The examiner acknowledges that the increased stability has apparently been demonstrated, as argued at pages 7-9 of the Remarks. This data is not persuasive of patentability, however, because the instant claims are not commensurate in scope with the instant claims [sic], insofar as they do not positively recite any specific DEGREE of stability, the time over which that stability is maintained, etc. Moreover, for essentially this same reason, the examiner does not agree that the prior art "teaches away" from the instantly claimed subject matter as argued by applicant at page 9 of the Remarks. And finally, again using the same reasoning, since no DEGREE of stability is specifically recited, the fact that e-aminocaproic acid is used as a buffer by the prior art is not relevant to this analysis."

During the telephone interview, Supervisory Examiner Krass said that to avoid the prior art rejection set forth in the October 19, 2007 Office Action (rejection of the pending claims over USP 6,011,062 to Schneider et al.), contrary to the statement at the top of page 2 of the March 25, 2008 ADVISORY ACTION, it may not be necessary to submit further data, but rather to amend the claims to recite the time period for the stability and possibly also the degree of the stability.

During the telephone interview, the undersigned made an argument that it should not be necessary to amend the claims, since advantages inherent in a claim which render the claim patentable over the prior art need not be recited in the claims.

In re Estes, (CCPA 1970) 164 USPQ 519 and In re Merchant, (CCPA 1978), 197 USPQ 785,788 which states as follows:

"We are aware of no law requiring unexpected results relied upon for patentability be recited in the claims."

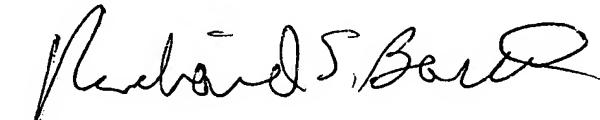
Supervisory Examiner Krass stated that he would consider the argument discussed in the preceding paragraph if the argument is presented in a RESPONSE. However, Supervisory Examiner Krass said that he would have to study the matter in more detail before he could decide whether or not he considers such argument to be persuasive.

In addition to presenting the above argument or as an alternative to presenting the above argument, Supervisory Examiner Krass suggested that the claims be amended to recite a time period for stability and possibly also a degree of stability.

For the reasons discussed in the AMENDMENT FILED CONCOMITANTLY WITH RCE (which is being filed concomitantly herewith), applicants' claims were not amended to recite a time period for stability or a degree of stability, because such

amendments are considered to be unnecessary for distinguishing applicants' claims over USP 6,011,062 to Schneider et al.

Respectfully submitted,



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